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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,502	01/15/2004	David Benderly	BENDERLY	6160
156	7590	11/29/2004	EXAMINER	
KIRSCHSTEIN, OTTINGER, ISRAEL & SCHIFFMILLER, P.C. 489 FIFTH AVENUE NEW YORK, NY 10017			HEINRICH, SAMUEL M	
			ART UNIT	PAPER NUMBER
			1725	

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,502

Applicant(s)

BENDERLY, DAVID

Examiner

Samuel M Heinrich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 18-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-23 and 26-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 20-22, 28, and 29 further limit the “forming stencils with cutouts” step recited in claim 18. The dependent claims state “the forming step is performed by” either “filling the cutouts”, “applying an adhesive”, “overlaying each stencil with a cover layer”, “performed at a manufacturing site”, or “performed at the sites at which marking is performed.” These “forming steps” do not clearly further define the claimed method of “forming stencils with cutouts” as recited in claim 18. Claim 23 further defines claim 20, but does not make the forming step clear.

Claims 26 and 27 describe performing the steps at a “jewelers premises”. This limitation does not clearly further define the claimed marking process.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by USPN 3,657,510 to Rothrock. Rothrock describes the use of a mask to form altered surfaces.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-25, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 3,657,510 to Rothrock. Forming the apparatus of Rothrock at a site remote from the site where the apparatus is used would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because the apparatus manufacturing requires different tooling than required for using the marking apparatus. The instant claimed forming steps would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because "forming stencils with cutouts" require forming steps which produce cutouts. Sequential numbers or logos are well known stencil elements and enabling marking of an object by forming stencil cutouts would have been obvious at the time applicant's invention was made to a person having ordinary skill because the stencil is well known for marking.

Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,467,172 to Ehrenwald et al. Ehrenwald et al describe the well known laser marking system and describe (Abstract) marking a diamond gemstone. Ehrenwald et al describe related art, e.g., USPN 3,657,510 to Rothrock, and the use of the mask element described by Rothrock would have been obvious at the time

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applicant's invention was made to a person having ordinary skill in the art because the use of the mask is described as an alternative, but less efficient, marking method.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited art pertains to marking systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel M Heinrich whose telephone number is 703 308 1168. The examiner can normally be reached on M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G Dunn can be reached on 703 308.3318.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Samuel M. Heinrich

11-26-2004

Samuel M Heinrich
Primary Examiner
Art Unit 1725

SMH